

REMARKS

Reconsideration is requested.

Claims 13-37 are pending.

The specification has been amended to recite the means by which the molecular weight of the ethylene homopolymers and copolymers are measured. No new matter has been added and the Examiner is requested to consider the attached and the following in this regard.

A copy of the file history of U.S. Patent Application No. 08/538,550 (hereinafter, the “‘550 application”) is attached for the Examiner’s consideration. The ‘550 application was originally filed without a description of the method of measuring the molecular weight. See, page 7, lines 4-10 of the ‘550 application. The ‘550 application was amended to further define the method of measuring the molecular weight (i.e., “as measured by vapor phase osmometry”) in an Amendment dated June 17, 1996. The Examiner of the ‘550 application (Examiner Glass) objected to the amendment as entering new matter. See, Paper No. 5 in ‘550 application file history. The applicants of the ‘550 application (hereinafter “Stepniewski”) argued in response that:

In the present case the amendment [to the specification] simply clarifies the means by which the molecular weight of a fully disclosed compound is determined. In other words, it makes explicit what is implicitly disclosed in the specification. See, *Wright, supra [In re Wright, 145 USPQ 182 (CCPA 1965)]*. The molecular weight of an exemplified compound, as well as the identity of the manufacturer, is explicitly disclosed; the means by which that molecular weight determination is made is implicit in the disclosure of the compound and its manufacturer, as shown by the present submissions. [i.e., the Declaration of George J. Stepniewski Under 37 CFR §1.132, executed December 17, 1996,

and related attachments (hereinafter, the "Stepniewski Declaration"). Therefore, the amendment of the specification and claims to include this material does not constitute new matter, and overcomes the rejection under §112, second paragraph.

See, Response Under 37 CFR §1.116 bearing USPTO date stamp of 12/23/96. The Stepniewski Declaration includes Exhibits A and B which are reported to be a copy of the product literature from Petrolite Corporation and a copy of a description of the specifics of the vapor phase osmometry methodology, respectively. Petrolite Corporation was described by Stepniewski to be the manufacturer of Stepniewski's exemplified Siltek PL™ polyethylene solidifying agent.

See, page 7, lines 8-10 of the '550 application and the Declaration of George J. Stepniewski Under 37 C.F.R. §1.132 executed June 20, 1996.

Exhibit A of the Stepniewski Declaration indicates that the presently exemplified ethylene homopolymers "Polywax 500", "Polywax 655" and "Polywax 1000" have a molecular weight, as measured by vapor pressure osmometry, of 500, 655 and 1000, respectively. See, present application at page 5, lines 9-14 and the attached priority application FR 94 00843, and English translation thereof, at page 3, lines 13-18 and page 3, lines 25-30, respectively. See also, page 3, lines 13-18 of the attached patent issuing from the priority application FR 94 00843 and page 3, lines 11-15 of the attached English translation thereof. The FR 94 00843 application was published July 28, 1995, i.e., prior to the filing of the '550 application.

Examiner Glass allowed the '550 application in response to the Stepniewski Declaration and stated:

As indicated in applicant's response this [amendment to the specification and claims to recite "as measured by vapor phase osmometry"] does not constitute new matter since applicant has

shown that this is a property inherently present in the polyethylene disclosed in the specification.

See, Notice of Allowability dated January 13, 1997 (Paper No. 11) in the '550 application file history.

Similarly, the above amendment to the above-identified application is submitted to be inherent in the present applicants' disclosure of the exemplified Petrolite compounds. Entry of the amendments is requested.

The obviousness-type double patenting rejection of claim 5 over claim 1 of U.S. Patent No. 5,556,613 is moot in view of the above. Withdrawal of same is requested.

The obviousness-type double patenting rejection of claims 13-37 over claims 1-25 of U.S. Patent No. 5,648,066 is traversed. Reconsideration and withdrawal of the rejection is rejected as there is no common inventor or assignee between the present application and the cited patent. The grant of claims 13-37 will not be an unjustified or improper timewise extension of the "right to exclude" granted to Estee Lauder Corporation, assignee of U.S. Patent No. 5,648,066. A terminal disclaimer cannot be filed to overcome this rejection as the application and patent are not commonly owned. The obviousness-type double patenting rejection is improper and should be withdrawn.

The applicants note U.S. Patent No. 5,648,066 was filed October 3, 1995 while the present application is based on FR 9400843, filed January 26, 1994 (certified copy attached with certified English translation). The present invention was therefore made by the present applicants more than a year prior to the Stepniewski filing date. FR 9400843 was published July 28, 1995. That is, the priority document of the present application was published over 2 months

prior to the filing date of the application which matured into U.S. Patent No. 5,648,006. FR 9400843 was granted on March 22, 1996 (certified copy attached as well as a certified English translation of the patent).

The Section 112, first paragraph rejection of claims 13-37 is traversed. Reconsideration and withdrawal of the rejection is requested in view of the following. Should the rejection be maintained after review of the following and the attached, the Examiner is requested to indicate, with particularity, what aspect of the claimed invention is not supported by the present disclosure.

Claim 13 provides a solid silicone composition for topical application to human skin or hair. Support exists at page 10, lines 9-10 of the present specification (hereinafter "S"), page 7, lines 1-2 of the attached English translation of the priority document (hereinafter "P") and page 5, lines 6-7 of the attached English translation of the granted patent (hereinafter "GP") (solid products), page 2, lines 23-24 of S, page 2, lines 3-4 of P and page 1, lines 33-34 of GP (cosmetic or dermatological composition containing silicone) and page 4, last line of S, page 3, lines 17-18 of P and page 3, lines 4-5 of GP (composition for application to the skin and keratin fibers (i.e., hair)).

The composition of claim 13 contains 3 to 30 percent by weight of the total composition of a polyethylene solidifying agent which is a straight chain homopolymer of polyethylene having an average molecular weight of about 500 or less as measured by vapor pressure osmometry. Support exists at page 3, lines 7-10 after formula (I) of S, page 2, lines 7-10 after formula (I) of P and page 2, lines 6-8 after formula (I) of GP, wherein a lower range of 3% is disclosed, and page 5, line 22 of S, page 4, line 7 of P and page 3, line 21 of GP , where an upper

range of 30% of the total weight of the fatty phase, which is the entire composition, of an ethylene homopolymer is described. The molecular weight of the polymer is described as being in the range of 200 to 1,500. "Polywax 500" is described at page 5, lines 10-11 of S, page 3, lines 25-27 of P and page 3, lines 11-12 of GP, as the preferred ethylene homopolymer. The molecular weight of "Polywax 500" is 500, as described above and in the attached. The range of "an average molecular weight of about 500 or less" is supported by this disclosure of the "Polywax 500" and the description of a molecular weight of 200. Support for the recitation "measured by vapor pressure osmometry" is inherently found in the disclosure, as described above. Support for the recited 10 to 97 percent by weight of a non-volatile silicone fluid, of claim 13, is found at page 3, line 3 and page 4, line 17 of S. Similar support is found at page 2, line 6 and page 3, line 12 of P and page 2, line 1 and page 2, penultimate line of GP.

Support for the range recited in claim 14 is found at page 3, line 7 after formula (I) and Examples 1, 4 and 5 of S, page 2, line 7 after formula (I) and Examples 1, 4 and 5 of P and page 2, line 6 after formula (I) and Examples 1, 4 and 5 of GP.¹

Support for the amount recited in claim 15 is found in Examples 2 and 3 of S, P and GP. (The undersigned notes "ricin" of the original French documents is known as the castor oil plant such that "ricin oil" of page 13, line 19 is submitted to be the same as castor oil of Example 3 of P and GP.)

¹ The undersigned notes an inadvertent typographical error exists in Example 1 of P and GP in that "AC 1702" of the original French text is stated in P and GP as "AC 1072) these are clear errors which should not require submission of corrected copies. The applicants will, however, provide corrected copies upon the Examiner's further request. The attached P and GP documents are altered versions of that which was certified by the translator in that formula (I) of each document, wherever it appears in the attached has been reproduced from the original French document to accurately reflect the chemical structure. The documents certified by the translator contained

Support for the ranges recited in claims 16 and 17 is found at page 4, lines 7-9 of S, page 3, lines 5-6 of P and page 2, lines 7-8 after formula (II) of GP.

Support for claims 18 and 19 is found in the specification at page 3, lines 2 to 4 after formula (I) of S, page 2, lines 2-4 after formula (I) of P and page 2, lines 2-3 after formula (I) of GP, wherein n=0 and R is an alkyl of one carbon atom.

Support for claim 20 is found at page 6, line 4 to page 7, line 19 of S, page 4, line 17 to page 5, line 9 of P and page 3, line 31 to page 4, line 5 of GP.

Support for claim 21 is found at page 7, line 3 of S, page 4, line 28 of P and page 3, line 42 of GP.

Support for claim 22 is found at page 7, lines 5-10 of S, page 4, line 30 to page 5, line 2 of P and page 3, lines 44-47 of GP.

Support for claims 23 and 37 is found at page 9, lines 22-23 and page 10, line 7 of S, page 6, line 12, page 9, line 16 and page 10, line 14 of P and page 4, line 38, page 6, last line and page 7, line 19 of GP.

Support for claim 24 is found at page 9, lines 11-23 of S, page 6, lines 17-27 of P and page 4, line 43 to page 5, line 2 of GP.

Support for claim 25 is found at page 9, lines 14-15 of S, page 6, lines 20-21 of P, and page 4, line 46 of GP.

Support for claims 26 and 36 is found at page 9, lines 14-15, the above noted passages of P and GP, and the general understanding that titanium dioxide and zinc oxides are sunscreens.

inaccurate and incomplete structures. These changes to the structures made by the undersigned do not constitute a change in the certified English translation of the French text as the original structures are not French.

See, for example, column 5, line 18 of U.S. Patent No. 5,648,066 ("inorganic sunscreens, such as titanium dioxide and zinc oxide").

Support for claims 27 and 28 is found at page 10, line 6 of S, page 6, lines 10-12 of P and page 4, lines 36-38 of GP.

Support for the recitations (c) and (d) of claim 29 is found at page 6, lines 8-10 and page 9, line 9 of S, respectively. Support for recitation (c) of claim 29 is found at page 4, lines 20-21 of P and species within recitation (d) of claim 29 are found in the Examples of P. Similar support exists in GP.

Support for claims 30 and 31 is found at page 10, lines 15-24 of S, page 7, lines 7-14 of P and page 5, lines 12-20 of GP.

Support for claims 32-34 is found at page 10, lines 8-14 of S, page 7, lines 1-6 of P and page 5, lines 6-11 of GP.

Support for claim 35 is found at Example 3 and page 3, line 3 of S, Example 3 and page 2, line 6 of P and Example 3 and page 2, line 1 of GP.

Claims 13-37 are supported by an enabling disclosure and withdrawal of the Section 112, first paragraph rejection of same is requested. The claims are supported by the priority document and benefit of same is appropriate.

In view of the above and the attached, the applicants request an indication that claims 13-37 are allowable to the applicants.

Respectfully submitted,

NIXON & VANDERHYE, P.C.

By: B.J. Sadoff
B.J. Sadoff
Reg. No. 36,663

BJS:rdw
Attachments

1100 N. Glebe Rd.
11th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4091
Facsimile: (703) 816-4100